

IV. REMARKS

In the above-referenced patent application, please enter the amendment and reconsider the application in view of that which is set forth below. It is believed that no new matter has been added. It is noted that the claims have been substantially amended, such that the rejections are believed to be moot, but Examiner guidance is provided below in response to the rejections. Many of the amendments are to tidy up the claims, and thus should be considered without prejudice.

For example, in the Office Action, claim 21 has been made subject to an objection. The Examiner contends that dependent claims must be depending from a preceding claim. In response, please cancel claim 21 without prejudice and consider claim 29.

Claims 18-24 have been rejected pursuant to 35 U.S.C Sec. 102(b). The Examiner contends that these claims are anticipated by Laurash, for reasons more precisely stated in the Office Action. The Examiner contends, among other things, that "Laurash discloses separating (perforating lines for separating, fig. 1, col. 2, lines 10-11) the parts prior to shipping."

This contention is respectfully traversed: Laurash discloses that the tearing is carried out by the recipient, and thus after the shipping. Laurash does not teach Applicant's claimed separating the parts prior to shipping... The Examiner's attention is drawn to Laurash at Col. 5., lines 63-68, where Laurash states:

"The tucked upper and center panels are designed to be removed from the remainder of label 10 by the recipient of the package by grasping and pulling tab 40 and tearing along lines of perforation 28, 30, and 32. Once removed from the remainder of the label construction, panel 16 acts as a receipt for the customer."

Thus, Laurash teaches a process whereby there can be separating *after* shipping, contrary to Applicant's claimed separating the parts prior to shipping... Further, Laurash also does not teach Applicant's claimed but no other of said at least two parts located outside the package during the shipping. Instead, Laurash discloses (Fig. 1 and at Col. 2, lines 11-15) more than

one of a packing list, a consumer ordering system-customizable component, and a shipping sheet is located on the exterior of the package during shipping. In sum, Laurash's disclosure is not the same as what is claimed in claim 18, and contradicts Applicant's claim elements as a whole. Laurash also does not anticipate claims 19-24, all of which include these elements. Because the remainder of the anticipation rejection depends on cooperation of parts not shown in Laurash, claim by claim, this lack of cooperation respectively serves as the basis for a respective traversal of the rejection for each of claims 18-24.

Additionally, if a rejection is maintained, Applicant most respectfully requests (pursuant to 35 USC Sec. 132) information sufficient to track Applicant's claim elements to the cited art and a more precise identification of what is alleged to be disclosed in the cited art. For example, as regards the rejection of claim 2, the Examiner contends that Laurash teaches printing on all of the areas. The Examiner is requested to provide particular information as to what portions of Laurash's label in Figure 1 are contended to correspond to the areas set out in Applicant's claims: it appears that nothing is printed on the bottom 1/3 of the Laurash label in Figure 1. As an other example, claim 21 has been rejected based on a contention that Laurash discloses TCP/IP communication at Col. 2, lines 1-3, but Applicant cannot understand the basis for this contention, and other contentions in all other claims do not seem to correspond to Laurash. Most respectfully, Applicant is merely requesting sufficient information to be able to respond, if such response is necessary after consideration of the amendment and remarks herein.

More particularly, with regard to claim 19, the Examiner contends that Laurash discloses that the shipping does not include shipping the packaging list part with the package and cites to Col. 4., lines 50-60. The contention is respectfully traversed as there is no such disclosure. Laurash teaches a process whereby there can be separating *after* shipping, contrary to Applicant's claimed separating the parts *prior to shipping*... Laurash's disclosure is

not the same as what Applicant has claimed, and thus Laurash does not establish anticipation.

More particularly, with regard to claim 20, the Examiner contends that Laurash discloses that the shipping does includes shipping the customizable component part within the package and cites to Col. 4., lines 50-60. The contention is respectfully traversed as there is no such disclosure. Laurash teaches a process whereby there can be separating *after* shipping, contrary to Applicant's claimed separating the parts prior to shipping.... Laurash's disclosure is not the same as what Applicant has claimed, and thus Laurash does not establish anticipation. See, e.g., Applicant's paragraph that is two paragraphs above, herein.

More particularly with regard to claim 29, which is in effect a renumbered claim 21, the substance of this claim has been rejected based on a contention that Laurash discloses TCP/IP communication at Col. 2, lines 1-3, but Applicant cannot understand the basis for this contention because there seems to be no mention whatsoever of TCP/IP communication. Further, the Examiner contends that Laurash's printer can inherently be used to print any type of flower. But using a printer to print is not what Applicant's the claim requires. The claim specifies that the packing list is printed comprising a type of flower which is not inherent in Laurash or disclosed in Laurash. Laurash also teaches away from the Examiner's contention: Figure 1 of Laurash twice mentions a "Part No." which is an inapposite way of thinking of a type of flower. Because Laurash does not teach either TCP/IP communication or that the packing list is printed comprising a type of flower Laurash's disclosure is not the same as what Applicant has claimed, and thus Laurash does not establish anticipation.

More particularly with regard to claim 24, the rejection is premised on contentions addressed above, and incorporated by reference herein too.

Claims 1-3, 9-17, and 25-28 have been rejected pursuant to 35 U.S.C Sec. 103(a). The Examiner contends that these claims are obvious based on Laurush, in view of Ramsden, for reasons more precisely stated in the Office Action.

In response, the rejection is respectfully traversed, at least because the cited art does not disclose Applicant's claimed customer-specified date in connection with the claim as a whole. In the Office Action, the Examiner contends at page 5 that "Ramsden... teaches a well-known example of printing a delivery date." The Examiner points to Fig. 18a, 22b, Col. 2, lines 39-67." In response, if the rejection is maintained, Applicant respectfully requests (pursuant to 35 USC Sec. 132) information sufficient to understand the contention and a more precise identification of what is alleged to be disclosed as "printing a delivery date." There appears to be no disclosure whatsoever in Ramsden of "printing a delivery date." No cited art teaches or suggests printing more than one date on the waybill area or any mechanism to do so, in the context of the claims each as a whole. If the rejection is maintained, Applicant respectfully requires (pursuant to 35 USC Sec. 132) more precise identification of what is alleged to be disclosed in Ramsden as "printing a delivery date" and some apparatus or method explicitly adapted to print the two claimed dates on the waybill area.

Applicant also requests a more particular explanation of the reason to combine. The Examiner mentions that having such a date on the waybill allows the carriers and the customers to easily identify the date of delivery to ensure the product arrives on time. It is not apparent how the customer seeing the date on a waybill would play any role in delivery of the product on time. As to verification for the customer, Ramsden discloses "The delivery date and cost for all available service options are then displayed to the customer on the CRT 322" and the Examiner's explanation is required as to how some printing on the waybill would otherwise be motivated. As to the Carrier, delivery date appears to be based on the service available as selected by the customer, and the computed delivery date appears to be used for pricing, and is displayed on the CRT to enable a customer selection. There is no teaching or suggestion that somehow printing the Ramsden delivery date on the waybill portion has anything to do with ensuring that the product arrives on time. See Col. 21, lines 5-28. Indeed, there is nothing

explicit in Ramsden that the delivery date is printed on the waybill. In sum, the motivation for the purported combination is inconsistent with what is disclosed in the cited art, and the Examiner's explanation and a proper reason to combine is required.

Perhaps the foregoing is rendered moot by Applicant's amendment. Ramsden discloses that "the delivery date.. is computed at step 526" whereas Applicant's claims have been amended to printing, on the waybill area, a courier waybill and a ship date and a customer-specified date. It is respectfully submitted that no cited art teaches or suggests printing, on the waybill area, a courier waybill and a ship date and a customer-specified date, and therefore there is no *prima facie* statutory obviousness.

Because the remainder of the obviousness rejection depends on cooperation of parts not shown in Laurush, in view of Ramsden, claim by claim, this lack of cooperation respectively serves as the basis for a respective traversal of the rejection for each of claims 1-3, and 9-17, and customer-specified date is not shown as to claims 25-28, either.

With regard to the rejection of claims 2-3, the claimed cooperation of the parts has not been shown for the reasons given above, though the rejection may be moot in view of the amendment to claim 1. Because at least one claim element has not been shown in the cited art, a case of statutory obviousness has not been made out based on the cited art.

With regard to the rejection of claim 9, the Examiner contends that a laser printer as taught by Laurash is well known to print customized component on a preexisting art work including an ornamental design, and cites to Col. 5, lines 29-45. However, using a printer to print is not what Applicant's claim requires. The claim specifies printing customer-specified ornamental design on the waybill area which is not taught in Laurash, e.g., at Col. 5, lines 29-45. Further, the fact that a printer can print does not mean that everything that existed or ever will exist has been printed in the prior art – or that the cited art is sufficient for *prima facie* obviousness of what Applicant has claimed. Because at least one claim element has not been

shown in the cited art, a case of statutory obviousness has not been made out based on the cited art.

As to the rejection of claim 10, the Examiner contends that Laurash teaches Applicant's claimed steps of separating and the shipping. The contentions are respectfully traversed, and the Examiner's attention is drawn to Applicant's discussion above regarding claims 18-24. Laurash does not teach Applicant's claimed shipping the package, with the customizable component within the package at least because Laurash teaches a process whereby there can be separating *after* shipping, contrary to the instant claim requirement. Because at least one claim element has not been shown in the cited art, a case of statutory obviousness has not been made out based on the cited art.

Regarding the rejection of claim 11, the Examiner contends that Laurash teaches Applicant's claimed steps of separating and the shipping. The contentions are respectfully traversed, and the Examiner's attention is again drawn to Applicant's discussion above regarding claims 18-24. Laurash does not teach Applicant's claimed shipping a package... but no other said printed piece is outside the package at least because Laurash teaches a process whereby there can be separating *after* shipping, contrary to the instant claim requirement. Because at least one claim element has not been shown in the cited art, a case of statutory obviousness has not been made out based on the cited art.

With regard to the rejection of claim 12, the Examiner contends that one can choose not to include the packing list, which is well known and widely used in the shipping industry, for example FedEx, UPS.... The contention is respectfully traversed. The issue of statutory obviousness is not whether some claim element exists in isolation, but whether the claim as a whole was obvious based on particular evidence. Laurash explicitly teaches that the tearing is done by the recipient, as discussed herein with respect to claims 18-24, and it is not proper to contend obviousness when the contention contradicts an explicit teaching of the

primary reference. Because at least one claim element has not been shown in the cited art, a case of statutory obviousness has not been made out based on the cited art.

As to the rejection of claims 13-14, the claims have been amended such that the rejection is moot.

Regarding the rejections of claims 15-17, the Examiner contends that a laser printer as taught by Laurash is well known to print customized component on a preexisting art work including an ornamental design, and cites to Col. 5, lines 29-45. However, using a printer to print is not what the respective claims require. Claim 15 specifies that the customizable component comprises a customer-specified ornamental graphic which is not taught in Laurash, e.g., at Col. 5, lines 29-45. Claim 16 specifies that the customizable component comprises preexisting artwork which is not taught in Laurash, e.g., at Col. 5, lines 29-45. Laurash does not mention art work or that it is preexisting. Further, the mere fact that a printer can print does not mean that everything that existed or ever will exist has been printed – or that the evidence is sufficient for *prima facie* obviousness of what Applicant has claimed. Applicant has traversed the rejection of each claim mentioned in Claim 17, and the Examiner's attention is drawn above for the traversals, again respectfully traversed here. Because at least one claim element has not been shown in the cited art, a case of statutory obviousness has not been made out based on the cited art.

As to the rejection of claim 25, the Examiner contends that claim 25 recites the same limitations as claim 1, and that the rejection is for the same basis. In response, the rejection is respectfully traversed. While the Examiner's attention is drawn to Applicant's traversal of the rejection of claim 1, e.g., re no teaching of customer-specified date, claims 1 and 25 have distinct requirements, and Laurash does not mention the claimed web site either. Obviousness has not been made out based on the cited art.

As regards the rejection of claim 26, the Examiner contends that one can choose

not to include the packing list, which is well known and widely used in the shipping industry, for example FedEx, UPS.... The contentions are respectfully traversed. The issue of statutory obviousness is not whether some claim element exists in isolation, but whether the claim as a whole was obvious based on particular evidence. Laurash explicitly teaches that the tearing is done by the recipient, as discussed herein with respect to claims 18-24, and it is not proper to contend obviousness when the contention contradicts an explicit teaching of the primary reference. Because at least one claim element has not been shown in the cited art, a case of statutory obviousness has not been made out based on the cited art.

Regarding the rejection of claim 27, Applicant has traversed the rejection of each claim mentioned in Claim 17, and the Examiner's attention is drawn above for the traversals, again respectfully traversed here. Because at least one claim element has not been shown in the cited art, a case of statutory obviousness has not been made out based on the cited art.

As to the rejection of claim 28, the Examiner contends that a laser printer as taught by Laurash is well known to print customized component on a preexisting art work including an ornamental design, and cites to Col. 5, lines 29-45. However, using a printer to print is not what the respective claims require. Further, the mere fact that a printer can print does not mean that everything that existed or ever will exist has been printed – or that the evidence is sufficient for *prima facie* obviousness of what Applicant has claimed. Claim 28 specifies printing an ornamental design on the waybill component which is not taught in Laurash, e.g., at Col. 5, lines 29-45. Laurash does not mention ornamental design. Because at least one claim element has not been shown in the cited art, a case of statutory obviousness has not been made out based on the cited art.

Claims 4-8 have been rejected pursuant to 35 U.S.C Sec. 103(a). The Examiner contends that these claims are obvious based on Laurush and Ramsden, in view of Bezos, for reasons more precisely stated in the Office Action.

In response, the rejections are respectfully traversed, but many of these claims have been substantially amended so as to render the rejection moot.

First, however, the Examiner contends that Bezos is in the same field as Laurash and Ramsden. But these patents are in different classes and presumably would have been made subject to a restriction had the claims appeared in the same application. Noting that Laurash's filing date comes shortly after the development of the browser, Applicant contends that these patents are in unrelated arts. If a rejection is maintained, it is incumbent on the Examiner to establish that these are in the same field, as he has contended.

Second, again, the rejection builds on distinctions already set out with respect to the claim from which this claim depends.

Third, the claimed signals have not been shown to correspond to that which is claimed in the amended claims.

New claims distinguish over the cited art for the reasons cited herein.

The application is believed to be in condition for allowance, and favorable action is requested. If the prosecution of this case can be in any way advanced by a telephone discussion, the Examiner is requested to call the undersigned at (312) 240-0824.

With respect to the present application, the Applicant hereby rescinds any disclaimer of the scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer, if any, and the prior art that it was made to avoid, may need to be revisited. Nor should a disclaimer, if any, in the present application be read back into any predecessor or related application.

APPLICANT CLAIMS LARGE ENTITY STATUS. The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235, and if any extension of time is needed to reply to said office action, this shall be deemed a petition therefore.

Please direct all communication to the undersigned at the address given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "P.K.T.", is placed above a dotted line.

Date: May 27, 2008

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